

Notice of Allowability

Application No.

10/729,960

Examiner

Janis L. Dote

Applicant(s)

TOMITA ET AL.

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1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Jan. 8, 2008.
2. ☒ The allowed claim(s) is/are 1-5, 7 and 9-12.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

1. The examiner acknowledges the amendment to claim 1 and the cancellation of claim 13 filed on Jan. 8, 2008. Claims 1-5, 7, and 9-12 are pending.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance:

The rejection of claim 13 under 35 U.S.C. 112, second paragraph, sets forth in the office action mailed on Oct. 16, 2007, paragraph 6, has been mooted by the cancellation of claim 13 filed on Jan. 8, 2008.

The rejection of claims 1-5, 7, and 9-12 under 35 U.S.C. 103(a) over Emoto'074 combined with the other cited references, where Emoto'074 is considered prior art under 35 U.S.C. 102(e), set forth in the office action mailed on Oct. 16, 2007, paragraph 9, has been withdrawn because Emoto'074 has been shown not to be prior art under 35 U.S.C. 103(a) and 35 U.S.C. 103(c). Applicants' representative has shown that "the subject matter disclosed in Emoto'074, and the presently-claimed invention were, at the time the presently-claimed invention made, commonly owned." See the remarks filed on Jan. 8, 2008, page 6, second full paragraph.

Claims 1-5, 7, and 9-12 are allowable over the prior art for the reasons discussed above, for the reasons discussed in the office action mailed on Oct. 16, 2007, paragraph 3, and for the reasons discussed below.

In the office action mailed on Oct. 16, 2007, paragraph 3, the examiner stated that the rejection under 35 U.S.C. 103(a) of claims 1-5, 9, 10, and 13 over US 6,235,441 B1 (Tanikawa) combined with the other cited prior art, set forth in the office action mailed on Apr. 24, 2007, paragraph 15, had been withdrawn in response to the amendment to claim 1 filed on Aug. 24, 2007, that added the limitation of then now-cancelled claim 6 that the releasing agent has a melting point of from 60 to 120°C and is present in the toner in an amount of from 1 to 20% by weight. As correctly stated in the office action, Tanikawa does not disclose the melting point of polyethylene wax in the toner exemplified in example 57 of Tanikawa; nor is there enough evidence in the present record for a person having ordinary skill in the art to reasonably presume that the polyethylene wax used in example 57 has a melting point as recited in instant claim 1. However, on further review of Tanikawa and the subject matter recited in instant claim 1, the statement that the toner in example 57 of Tanikawa has storage moduli that are within the ranges recited in instant claim 1 is no longer considered to be

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correct. As discussed in the office action mailed on Apr. 24, 2007, paragraph 15, page 20, lines 2-8, the Tanikawa toner in example 57 has a storage modulus G' at 80°C of $2.0 \times 10^5 \text{ Pa}$, where the value of G' at 80°C was determined from the graph in Fig. 6 of Tanikawa. In addition, from that same graph in Fig. 6, the storage modulus G' at 180°C is readily determined to be about $4.0 \times 10^3 \text{ Pa}$, which is within the range of $5.0 \times 10^2 \text{ Pa}$ to $1.0 \times 10^4 \text{ Pa}$ recited in instant claim 1. However, the 80°C storage modulus of $2.0 \times 10^5 \text{ Pa}$ is outside the range of " $5.5 \times 10^5 \text{ Pa}$ to $5.5 \times 10^7 \text{ Pa}$ " (emphasis added) recited in instant claim 1. Although Tanikawa at col. 11, lines 34-40, teaches that the toner may preferably have a storage modulus G' at 80°C in the range of $1.0 \times 10^5 \text{ Pa}$ to $2.0 \times 10^6 \text{ Pa}$, which overlaps the 80°C storage modulus range recited in instant claim 1, there is no teaching or suggestion in Tanikawa that the 180°C toner storage modulus may vary within the range of $5.0 \times 10^2 \text{ Pa}$ to $1.0 \times 10^4 \text{ Pa}$ recited in instant claim 1. Thus, in view of the teachings in Tanikawa, it would have been obvious for a person having ordinary skill to adjust through routine experimentation the toner composition of the toner in example 57 of Tanikawa, such that the resultant toner has an 80°C storage modulus within the scope of instant claim 1. However, it would not have been obvious to that person that said variation of toner composition

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would result in a toner having both an 80°C storage modulus and an 180°C storage modulus within the respective ranges recited in instant claim 1. Nor is there enough evidence in Tanikawa for that person to reasonably presume that said toner composition variation resulting in a toner having a 80°C storage modulus as recited in instant claim 1 would also result in that toner having a 180°C storage modulus as recited in instant claim 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLD

Jan. 10, 2008

Janis L. Dote
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PRIMARY EXAMINER
GROUP 1500
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